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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10003227-1

(HE12-157)

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Natalie King

Application Number

09/738,795

Filed

12/13/2000

First Named Inventor

Robert E. Haines

Art Unit

2624

Examiner

Thierry L. Pham

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s) (see Pre-Appeal Brief A)

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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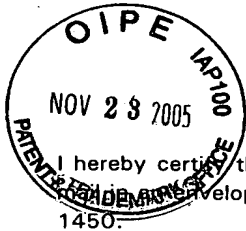
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**PATENT APPLICATION
DOCKET NO. 10003227-1**

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Robert E. Haines

SERIAL NO.: 09/738,795

GROUP ART UNIT: 2624

FILED: December 13, 2000

EXAMINER: T. Pham

SUBJECT: A Consumable Management Device, An Image Forming System,
And A Method Of Replenishing An Imaging Consumable

PRE-APPEAL BRIEF A

Concurrent with the filing of a Notice of Appeal in connection with the above-identified application, the undersigned requests review of the Final Office Action dated September 20, 2005 (hereinafter "the Office Action") of the following issues.

There is no motivation to combine the teachings of Beauchesne with the teachings of Ohtani.

Appellant respectfully submits there is no motivation to combine the teachings of Beauchesne with the teachings of Ohtani for the reasons set forth in Appellants' response filed July 21, 2005 (hereinafter "the Response"). In particular, *In re Lee* cited therein states that proper motivational rational may not be established on subjective belief or unknown authority, and deficiencies of cited references cannot be remedied about general conclusions about what is basic knowledge or common sense. The court in *In re Lee* stated that the factual inquiry whether to combine references must be thorough and searching and based upon objective evidence of record.

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S/N: 09/738,795
Pre-Appeal Brief A

Referring to pages 9-11 of the Response, the rationale of the Office on page 4 of the Office Action is not supported by objective evidence of record. The Office submits the combination is appropriate to allow operators of Ohtani to easily match client and manufacturer part numbers using the teachings of the secondary reference Beauchesne. However, Ohtani is void of any teaching of experiencing problems with respect to identification of parts to be ordered. Appellants have failed to uncover any teachings in Ohtani of usage of plural part numbering systems wherein matching solutions of Beauchesne would be relevant. The Office has failed to identify any evidence to support its allegations that time consumption or costs would be reduced by the combination. In a telephone interview of November 15, 2005 requested by Appellants in an attempt to avoid appeal, the Office failed to identify any teachings of problems in Ohtani with respect to identification of parts to be ordered.

The Office on page 4 of the Office Action alleges that the combination would improve the operability of the printing system. The Office fails to identify any evidence of record that a combination of the references proposed by the Office would provide any benefit over the teachings of Ohtani taken alone. To the contrary of the position of the Office, Ohtani by itself discloses a comprehensive consumable management system which orders consumables. On page 8 of the Office Action, the Office baldly alleges that the combination improves the operability of the printing system by detecting and replacing parts as detected by the printer's sensors. However, Ohtani taken alone already provides a system which utilizes sensors to indicate when parts have run out or need replaced and which are used in combination with a comprehensive ordering system (see e.g., the sensors of Fig. 2 of Ohtani). Accordingly, the motivational rationale is redundant to the teachings of the primary reference being modified and fails to provide proper motivational rationale specified by the Federal Circuit to support a 103 rejection.

Claim 1 explicitly claims the processing circuitry being configured to convert the first designation and to generate and forward a second message for communication. Ohtani at col. 6, lines 27-38 or col. 7, lines 44-48 is *explicitly directed towards human intervention of the official to place an order for a consumable to avoid excessive consumable inventory*. Accordingly, there is no motivation to modify Ohtani to include processing circuitry configured to convert an

identifier and forward the second message in view of the teachings of Ohtani to explicitly provide user interaction to avoid problems of concern in Ohtani of automatically ordering consumables without user intervention. The explicit provision of user interaction in Ohtani teaches away from the proposed combination of further automating the reordering process of Ohtani to allegedly reduce cost and time consumption by implementing processing circuitry to perform the converting, the generation of the second message and the forwarding of the second message. Ohtani is concerned with problems regarding overstocking consumables and accordingly provides human intervention as opposed to the alleged motivation cited by the Office. The teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction.

The combination of Beauchesne and Ohtani fails to disclose the claimed processing circuitry recited in claim 1.

The combination of reference teachings fails to disclose or suggest the claimed processing circuitry of the image forming device performing the conversion. The teachings of Fig. 5d of Beauchesne are relied upon by the Office on page 4 of the Action as allegedly disclosing the claimed conversion. To the contrary, Fig. 5d merely discloses a prior art database organization and the Office has failed to identify any evidence of Beauchesne disclosing processing circuitry configured to perform the claimed conversion. *The mere listing of the plural part numbers in a database entry fails to disclose or suggest any conversion by processing circuitry or the generating or forwarding of the second message as positively claimed.* In the telephone interview of November 15, 2005, the Office failed to identify any teachings of the processing circuitry defined in claim 1. Further, modifying or providing processing circuitry of Ohtani to implement the claimed conversion and communication of the message is contrary to the human intervention teachings of Ohtani which provides the user ordering consumables to avoid overstocking of consumables. Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest positively-recited limitations of claim 1.

The combination of Beauchesne and Ohtani fails to disclose limitations of claims 2, 10 and 15.

Ohtani explicitly discloses the usage of different emails of Figs. 6-8 depending upon the needs of the facsimile device and Applicants have failed to find any teachings regarding a list including a plurality of designations of a plurality of consumables as claimed. Also, Figs. 3-6 of Beauchesne refer to database entries of parts and Applicants have failed to uncover any teachings of a message comprising a list of plural designations for plural consumables as claimed. The tenuous nature of the rejection is evidenced by the taking of Office Notice on page 9 of the Action which is traversed by Appellants. Positively recited limitations of claim 2 are not disclosed by the prior art and claim 2 is allowable for this additional reason.

There is no motivation to combine the teachings of Hayward with the teachings of Beauchesne and Ohtani.

The Office on page 7 of the Office Action states that the combination of Hayward is appropriate to order parts without human intervention and to improve the performance of the printing environment. Appellants respectfully submit the motivation is directly contrary to the teachings of Ohtani which utilizes an Official who provides human interaction (see cols. 6 and 7 cited above) to provide ordering and avoid overstocking. The combination of Hayward proposed by the Office and motivation is directly contrary to the explicit teachings of Ohtani and is the antithesis that one combine the references as proposed by the Office. The rejection of claims 27, 29 and 31 is improper for this reason.

Further, with respect to claims 28, 30, 32 Ohtani clearly provides *intervention of the user* to avoid problems of overstocking. There is no motivation to modify Ohtani to eliminate the explicit user intervention of Ohtani to arrive at the subject matter of claims 28, 30, 32 reciting automatic communication of the messages. The rejection of claims 28, 30, 32 is improper for this reason.

Claims 28, 30, 32 comply with the enablement requirement.

On page 2 of the Office Action, the Office alleges that the claims fail to comply with the enablement requirement. The Office alleges that the limitations of automatic generation and forwarding of a second message without user intervention are not enabled or comply with the written description. Appellants refer to Fig. 5 of the application and the associated teachings thereof which clearly enable and

describe the claimed limitations. The method of Fig. 5 describes plural steps which are executed by processing circuitry as provided by the specification at page 15, lines 18+. The Office will note the method performed by the processing circuitry performs the steps responsive to the ordered executable instructions in one embodiment and the method fails to access or act upon user input in the disclosed embodiment. Further, page 12, lines 25+ describe processing circuitry 44 receiving a first message, converts designations and forwarding second messages for communication all without accommodating user input in the described exemplary embodiments. In one embodiment, page 12, lines 3+ of the specification provide storage circuitry 42 comprising a look table usable by the processing circuitry 44 to correlate first and second designations of a consumable to implement conversion. MPEP §2163.02 (8th ed., rev. 2) states the test for sufficiency of support in a application is whether the disclosure relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." MPEP §2163.02 (8th Edition) *citing Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). Notably, the subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement. MPEP §2163.02 (8th ed., rev. 2). The limitations of claims 28, 30, 32 are enabled and described at least in view of the specification teachings identified above and the 112, first paragraph rejections are improper.

Conclusion

Appellants respectfully request reconsideration of at least the above-identified claim rejections and allowance of the respective claims for at least the above-identified reasons.

Respectfully submitted,

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By:


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Date: 11/21/05